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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/032,684	10/22/2001	Thomas R. Wulff	83573RLO	7300

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EXAMINER

ZURITA, JAMES H

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 01/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/032,684

Applicant(s)

WULFF ET AL.

Examiner

James H Zurita

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

Applicant amendment of 22 October 2004 changed claims 1, 2, 6-9.

Claims 1-9 are pending and will be examined.

Response to Arguments

Applicant's arguments filed 22 October 2004 have been fully considered but they are not persuasive.

Applicant argues that

...One image is chosen by the consumer and one image is chosen by the sponsor...
...In [Lockhart] the user selects the images. These are not selected by a sponsor....

These statements are misleading, for the following reasons:

Claim 1(b) appears to correspond to Fig. 4, step 420 through Fig. 5, step 500:

...transmitting at least one sponsor digital image and demographic requirements
identifying consumers and recipients ...

...specifying at least some of the sponsor digital images ...based upon correlation
between the demographic information and the demographic requirements identify at least
some of the sponsored digital images ...

Claim 1(c), on the other hand, take place at the agency, and appear to
correspond to Fig. 6, step 650-660, which state (emphasis added):

...sponsors **are selected**...[step 650]

...[the] **agency merges** consumer selected image and information with sponsor(s)
image(s) and information. [step 660]

As in applicant's claims, Lockhart discloses that "...variable text and other
variable data is merged...to produce the final mail item..." see at least Col. 10, lines 56-
67. While Some of the data that may be merged with a user's images and information

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such as advertisements, coupons, etc. Advertisements may be based on precise demographic data derived in part from a recipient's address, for example. Advertising graphic images are selected and provided by sponsors. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include images selected by a sponsor, matching and merging those images.

Please also refer to rejection of claim 1(b) in previous office action, which states, in part, that advertisers as sponsors, specify at least some of the digital images that are presented. Applicant has not argued or shown otherwise.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lockhart et al. (US 6,732,152) in view of Fredlund et al. (US 5,666,215).

Lockhart discloses methods and systems for printing and delivering images from digital image files from one or more recipients.

As in claim 1(a), Lockhart discloses that a consumer may electronically transmit digital images to a server at a centralized location (applicant's central receiving agency); see, for example, references to uploading images and file creation, at least Col. 5, line 40-Col. 7, line 4. A consumer may also upload demographic information that identifies the consumer or recipient; see, for example, at least references to demographics, Col. 15, line 46-64. A consumer may transmit digital images from location(s) remote from a

server on the network; see, for example, at least references to customers at client devices sending images to servers over communication channels such as the Internet, Fig. 1 and related text. The receiving agency, at a server, receives and stores digital images and other information in memory. See, for example, at least references to mail service computer 110 and associated storage, including databases. See also at least references to Image collections stored in databases, at least Col. 7, lines 5-20. The central receiving agency provides locator information to locate the images after a customer uploads the images. See, for example, at least Fig. 3 and related text concerning links to various images, such as a customer's images.

As per claim 1(b), Lockhart discloses that advertisers, media collection providers, partners and other parties (applicant's sponsors) may electronically transmit at least one sponsor digital image from a remote location, over a communications channel such as the Internet, to a server at a centralized location (applicant's central receiving agency). See, for example, at least references to image collections, partner web sites, Col. 6, lines 53-64. As above, the central receiving agency provides locator information to locate the images after a sponsor uploads the images. See, for example, at least Fig. 3 and related text concerning links to various images.

Along with various images, including advertising images, sponsors may transmit demographic requirements identifying consumers and recipients. For Advertisers as sponsors, please see at least Col. 15, lines 46-63. Sponsors may specify at least some of their digital images, which based upon a correlation between a sponsor's demographic requirements and demographic information that was provided by a

consumer, identify at least some of the sponsor's digital images. See, for example, at least references to geographically-targeted advertisements and advertisements based on consumer demographics at least in Col. 15, lines 23-Col. 16, line 24.

As per claim 1(c), Lockhart discloses that a consumer may identify a particular stored image using the corresponding image locator information and the location of one or more recipients. See, for example, at least Fig. 3 and browse button 306. A browse button permits a consumer to browse and identify a particular image using an image's memory locator. See also at least references to recipient location indicators, such as New Home/Address links in Fig. 3.

As per claim 1(d), Lockhart discloses merging into a digital file the consumer identified digital image and the corresponding sponsor digital images. See, for example, at least references to merging consumer images and sponsor images and text, at least Col. 10, lines 56-67.

As per claim 1(e), Lockhart discloses transmitting the corresponding merged digital file for the identified particular stored image in the memory and display such image and the merged information to the printing location of the consumer or identified recipients. See, for example, at least references to reviewing, Col. 11, line 53-Col. 12, line 40. A consumer may preview merged digital files at his printing location, home computer-client site via a web browser, for example. See also at least Fig. 4, item 404, which shows an image that may be previewed at a recipient's location.

As per claim 1(f), Lockhart discloses printing the merged image at the printing location corresponding to consumer-identified recipients. See at least Col. 14, lines 27-

63. Lockhart discloses delivering printed merged images to locations corresponding to the recipients; see at least Delivery, Col. 14, lines 63-Col. 15, line 7. See also references to printing and sending a mail item, at least Col. 12, lines 14-41.

As per claim 1(g), Lockhart discloses sponsor(s) making at least partial payment to the central receiving agency for the printing and delivering the merged digital file. See, for example, at least references to advertising potential, partial or complete underwriting of postage by sponsors, at least Col. 15, line 65-Col. 16, line 16.

As per claim 1, Lockhart **does not** specifically disclose merging files and including them in a package. Fredlund discloses uploading and merging music or voice files, and delivering them to customers.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Lockhart and Fredlund to disclose merging files and including them in a package. One of ordinary skill in the art at the time the invention was made would have been motivated to combine Lockhart and Fredlund to disclose merging files and including them in a package for the obvious reason that consumers may wish to personalize their packages by including their own voice files, possibly singing "happy birthday" or other message on particular occasions.

As per claim 2, Lockhart discloses that electronically transmitting and the identifying steps are preformed simultaneously. See, for example, at least Fig. 3 and browse button 306. A browse button permits a consumer to browse and identify a particular image using an image's memory locator. See also at least references to recipient location indicators, such as New Home/Address links in Fig. 3.

As per claim 3, Lockhart discloses that the recipient location information includes a distribution list originally resident in a personal computer or in a central server managed by the central receiving agency. See, for example, at least references to selecting destination addresses from address books, Fig. 2 and related text. See also Addressing, Col. 10, lines 40-55.

As per claim 4, Lockhart discloses that the recipient location information includes the address of each of the recipients and wherein the printed image is delivered by mail to the address of each of the recipients. For recipient addresses, see at least Addressing, address books, Fig. 2 and related text, and Col. 10, lines 40-55. The printed images are delivered by mail to recipient's addresses, as seen in Delivery, Col. 14, line 64-67. See also Fig. 1 and related text, including description of item 120, surface mail.

As per claim 5, Lockhart discloses that sponsor digital images may include advertising information. See at least references to advertisements, Fig. 3, related text and Col. 15, line 46-Col. 16, line 17.

As per claim 6, Lockhart discloses extracting demographic information from the recipient's address and correlating recipient demographic information to permit particularizing of information included in the package sent to one or more recipients. See, for example, at least references to targeting advertisements to recipients based on demographic information such as geographic location of a recipient's address, at least Col. 15, line 46-Col. 16, line 16.

As per claim 7, Lockhart **does not** specifically disclose that a package may include a digital audio file. Lockhart discloses customizing cards for particular occasions, such as birthdays and anniversaries. **Fredlund** discloses uploading and merging music or voice files. See, for example, at least Fig. 1 and related text. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Lockhart and Fredlund to disclose merging files and including them in a package. One of ordinary skill in the art at the time the invention was made would have been motivated to combine Lockhart and Fredlund to disclose merging files and including them in a package for the obvious reason that consumers may wish to personalize their packages by including their own voice files, possibly singing "happy birthday" or other message on particular occasions.

As per claim 8, Lockhart discloses that the package includes a digital video. See, for example, at least references to video image capture, Col. 9, line 60-Col. 10, line 2. See also references to user graphic images such as might provided by a digital camera, motion video camera and others, at least Col. 4, line 42-Col. 5, line 9.

As per claim 9, Lockhart discloses that the central receiving agency provides bills or charges to the consumer and the sponsor for the printing and delivery of the package. See, for example, at least references to account balances, postcard purchases, Col. 11, line 53-Col. 12, line 14.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H Zurita whose telephone number is 703-605-4966. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JZ
James Zurita
Patent Examiner
Art Unit 3625
30 December 2004

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